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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/750,344

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Francis J. Manasek

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/750,344	Applicant(s) MANASEK, FRANCIS J.	
	Examiner Jacqueline F. Stephens	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 12-14 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 12-14 and 19 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The claims present two different embodiments – 1) originally presented claims - the second end is adapted for extending just short of the genital region when the first end is positioned over the buttocks region; and 2) newly added claims - the second end has an extension that covers the genital region.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 12-14 and 19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

2. Applicant's arguments filed 5/24/05 have been fully considered but they are not persuasive. With respect to claims 1, 4, and 7, Applicant argues Yabrov shows only one shape, a bottle-based shape that is not the equivalent of the Applicant's preferred pear shape. Applicant further argues the Examiner has misapplied *In re Dailey*, in *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (The court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a

person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.). MPEP 2144.04 states "if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court.... If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection." Applicant argues the Background and Detailed sections of the present specification discusses the deficiencies of the prior art devices and how the Applicant's pear shape solves these problems. Although applicant discusses the significance of the pear-shape in the cited passages of the specification, the discussion is more specifically directed to a structure having a narrowed end region and a widened end region, which Yabrov teaches. The fact that Yabrov does not disclose a specific pear shape (with rounded edges) is what is considered by the Examiner to be a matter of design choice. Yabrov solves the same problem and has essentially the structure that is considered significant by the applicant, the narrowed end region and widened end region. Furthermore, Yabrov teaches length of the pad is variable for men and women and take into account the differences in genital structure between men and women (col. 3, lines 21-26). The specific 'pear shape" (with rounded edges) is what the Examiner considers as not to solve any particular problem. The problem of fit and comfort is solved by the narrowed end region and widened end region, which Yabrov teaches.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the porous inner layer lies in the center of the article on the bodymost surface, the porous inner layer is the top, or bodymost layer, and Applicant's invention has no semi-rigid or rigid containment components) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant argues Yabrov does not show the Applicant's porous inner layer and that element 2 of Yabrov is not in contact with the body of the wearer. Amended claim 1 now requires a liquid-permeable bodymost layer and Applicant's arguments with respect to this limitation are moot in view of the new ground(s) of rejection.

Additionally, the indication of allowable subject matter for claim 2 and its dependent claims has been withdrawn. The amendment to claim 2 is broader in scope than the original claim. Specifically, the claim does not require a narrower front region and wider back region and pear-shaped article.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the attached

disposable panty must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 7-9 and 17 claim an attached disposable panty. The

specification does not disclose an attached disposable panty, only that the panyliner adhesive technology can be used to affix the invention to close-fitting male or female unnderpants (specification page 10, lines 14-15).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 7-9 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose an attached disposable panty, only that the panyliner adhesive technology can be used to affix the invention to close-fitting male or female unnderpants (specification page 10, lines 14-15).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 4, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabrov et al.

9. As to claim 1, Yabrov discloses an article for protection from anal soiling comprising an impervious outer layer (col. 4, lines 14-17); an absorbent middle layer 7; and a porous inner layer 1 – Yabrov discloses outer shell 1 comprises lignin paper (col. 3, lines 39-40), and the examiner has reasonable factual basis to conclude the shell 1 is liquid permeable as it covers the absorbent pad 7 (Figure 3). The invention of Yabrov comprises a narrow end and a wide end that is capable of fitting over a users buttocks region (Figures 1, 2, and 8a-10c). Yabrov does not specifically disclose a pear-shaped article in that the edges of the Yabrov invention are not rounded, which typically denote a pear or gourd shape. The fact that Yabrov does not disclose a specific pear shape (with rounded edges) is what is considered by the Examiner to be a matter of design choice, since applicant has not disclosed that the rounded edge feature solves any stated problem or is for any particular purpose. Yabrov solves the same problem and has essentially the structure that is considered significant by the applicant, the narrowed end region and widened end region and it appears that the invention would perform equally well with the straight edges in the Yabrov invention. The problem of fit and comfort is solved by the narrowed end region and widened end region, which Yabrov teaches. It would have been an obvious matter of design choice to provide the article of

Yabrov with a pear shape – rounded edges, since such a modification would have involved a mere change in the shape of the component.

As to claim 4, Yabrov discloses an adhesive 8 on the back of the outer shell 1 (col. 4, lines 9-13) for removable attachment of the article to a garment. Yabrov does not disclose the outer shell 1 is impervious. Instead Yabrov discloses a separate impervious layer in combination with the outer shell 1. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yabrov to have an adhesive attached to an outermost impervious layer since forming in one piece an article, which has formerly been formed in two pieces and put together involves only routine skill in the art.

As to claim 7, see Figure 10a-10c.

10. Claims 2, 3, 5, 6, 8, 9-11, 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yabrov in view of Grosse USPN 5665081.

As to claims 2, 3, 9, 11, 15, and 18, Yabrov discloses an article for protection from anal soiling comprising an impervious outer layer (col. 4, lines 14-17); an absorbent middle layer 7; and a porous inner layer 1 – Yabrov discloses outer shell 1 comprises lignin paper (col. 3, lines 39-40), and the examiner has reasonable factual basis to conclude the shell 1 is liquid permeable as it covers the absorbent pad 7(Figure 3). The invention of Yabrov comprises a narrow end and a wide end that is capable of

fitting over a users buttocks region (Figures 1, 2, and 8a-10c). Yabrov does not disclose a dam on the article. Grosse discloses an anal pad having a dam for the benefit of extending in the anal region to attenuate noise emanating therefrom (Abstract). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the pad of Yabrov with a dam as taught in Grosse for the benefits Grosse discloses.

Yabrov/Gross does not specifically disclose a pear-shaped article in that the edges of the Yabrov invention are not rounded, which typically denote a pear or gourd shape. The fact that Yabrov does not disclose a specific pear shape (with rounded edges) is what is considered by the Examiner to be a matter of design choice, since applicant has not disclosed that the rounded edge feature solves any stated problem or is for any particular purpose. Yabrov solves the same problem and has essentially the structure that is considered significant by the applicant, the narrowed end region and widened end region and it appears that the invention would perform equally well with the straight edges in the Yabrov invention. The problem of fit and comfort is solved by the narrowed end region and widened end region, which Yabrov teaches. It would have been an obvious matter of design choice to provide the article of Yabrov with a pear shape – rounded edges, since such a modification would have involved a mere change in the shape of the component.

As to claims 5, 6, and 16, Yabrov discloses an adhesive 8 on the back of the outer shell 1 (col. 4, lines 9-13) for removable attachment of the article to a garment. Yabrov does not disclose the outer shell 1 is impervious. Instead Yabrov discloses a separate impervious layer in combination with the outer shell 1. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yabrov to have an adhesive attached to an outermost impervious layer since forming in one piece an article, which has formerly been formed in two pieces and put together involves only routine skill in the art.


As to claims 8 and 9, see Figure 10a-10c.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jacqueline F Stephens
Examiner
Art Unit 3761

August 22, 2005